

DOCKET NO.: **NI-0006
Application No.: 09/870,210
Office Action Dated: November 19, 2007

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Scott Wolinsky

Confirmation No.: 7821

Application No.: 09/870,210

Group Art Unit: 3714

Filing Date: May 30, 2001

Examiner: Dat Nguyen

For: METHOD AND APPARATUS FOR SIMULATING GAME ACCESSORIES

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant respectfully requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets. No more than five pages are provided.

REMARKS

Withdrawal of the Final Rejection is believed appropriate for the following reasons:

Rejections under 35 USC §102

Claim 1 is rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Darling (WO 93/23125).

Applicant respectfully submits that Darling does not disclose the subject matter recited in claim 1. In the Final Office Action dated November 19, 2007, the Examiner indicated that pages 10 and 11 of Darling teach transmitting and retrieving information stored in each gaming terminal's RAM, and this anticipates "identifying, at a first terminal, one or more remote terminals for a game by retrieving one or more stored numbers associated with said one or more remote terminals from memory of the first terminal." Applicant respectfully disagrees with the Examiner. Applicant respectfully submits that pages 10 and 11 of Darling teach transmitting game play information between devices that are currently in a game, that is, this portion of Darling is referring to ongoing games, and is not related identifying remote opponents for a game. Applicant submits that in Darling in order to identify terminals for games "a logon procedure is carried out." (Darling at p. 11). In Darling, a device that attempts to connect with another performs a logon procedure, that is, it transmits a logon packet that indicates the device's identity to another device. This logon packet is processed by the other device and the other device uses the information from the packet to identify devices for a game. (See Darling p.14 and basic packet information described on p. 18). Applicant submits that a terminal that identifies opponents for a game by retrieving one or more stored numbers associated with the opponents from memory of the terminal is patentably distinct from a terminal that identifies opponents for a game by receiving a packet of information that identifies the opponent. Accordingly, for at least this reason, Applicant respectfully requests reconsideration of the rejection of claim 1.

Insomuch as claims 2, 4, 7, 8 – 11 depend directly or indirectly from claim 1 they too patentably define over the references for at least similar reasons as claim 1. Accordingly, for at least the reasons discussed with respect to the rejection of claim 1, Applicant respectfully requests reconsideration of the rejections of claims 2, 4, 7, 8 – 11.

Independent claims 17 and 152 recite similar elements to those of claim 1 and also patentably define over Darling for at least the above stated reasons with respect to claim 1. Accordingly, Applicant respectfully requests reconsideration of the rejections of claims 17 and 152.

Insomuch as claims 18, 20, 23, 25, 26, and 27 depend directly or indirectly from claim 17 they too patentably define over the cited art for at least the above stated reasons with respect to claim 1. Accordingly, Applicant respectfully requests reconsideration of these rejections.

Rejections under 35 USC §103

Claim 7 and 8 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Darling in view of Online Monopoly and Tanskanen.

Applicant submits that claims 7 and 8 additionally define over Darling in view of Online Monopoly and Tanskanen for at least one additional reason. In order to prove a prima facie case of obviousness the Examiner must provide a reason as to why one of skill would combine the references in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 167 L.Ed.2d 705, 82 USPQ2d 1385, 1391 (2007). Applicant respectfully submits that the Examiner has not provided a sufficient reason as to why one of skill in the art at the time of invention would use DTMF signals of Tanskanen with the packet based communication feature of Darling. In the Office Action the Examiner stated that page 17, paragraph 4 of Darling teaches that any suitably adapted communications protocol can be used to transmit data and that a suitably adapted communications protocol can be a wireless telephone line using a DTMF signal as taught by Tanskanen and that one would combine them to “achieve the predictable result of a wireless gaming system which utilizes inband DTMF signals as a data transmission means. (Office Action at p. 4-5). Applicant disagrees with the Examiner’s characterization and interpretation of Darling. Applicant submits that the Examiner has paraphrased Darling, and the actual text of Darling states “data packets can be transmitted using any suitably adapted communications protocol known to those skilled in the art.” (Darling p. 17, paragraph 4) (Emphasis added). Applicant submits that this statement would lead one of skill in the art to use a suitably adapted communications protocol such as TCP or UDP to transmit packets. Applicant submits that the Examiner has not provided a sufficient reason as to why one of skill in the art would digitize DTMF signals and place the digital DTMF information in the packets of Darling. Applicant submits that since the Examiner has not provided a sufficient reason as to why one of skill in the art would combine the references in the manner claimed, the Examiner has failed to prove a prima facie case of obviousness. Accordingly, for at least this additional reason Applicant respectfully requests reconsideration of the rejection of claims 7 and 8.

Insomuch as claims 23 and 24 recite similar elements as claims 7 and 8 they too patentably define over the combination of references for at least similar reasons as claims 7 and 8. Accordingly, Applicants respectfully request reconsideration of the rejections of claims 23 and 24.

Claim 33 stands rejected under 35 U.S.C. § 103(a) as allegedly obvious over Darling in view of Online Monopoly and Tanskanen.

Similar to that described above with respect to claims 7 and 8, in order to prove a prima facie case of obviousness the Examiner must provide a reason as to why one of skill would combine the references in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 167 L.Ed.2d 705, 82 USPQ2d 1385, 1391 (2007). Applicant respectfully submits that the Examiner has not provided a sufficient reason as to why one of skill in the art at the time of invention would use DTMF signals of Tanskanen with the packet based device of Darling. In the Office Action the Examiner stated that page 17, paragraph 4 of Darling teaches that any suitably adapted communications protocol can be used to transmit data and that a suitably adapted communications protocol can be a wireless telephone line using a DTMF signal as taught by Tanskanen and that one would combine them to “achieve the predicable result of a wireless gaming system which utilizes inband DTMF signals as a data transmission means. (Office Action at p. 4-5). Applicant disagrees with the Examiner’s characterization and interpretation of Darling. Applicant submits that the Examiner has paraphrased Darling, and the actual text of Darling states “data packets can be transmitted using any suitably adapted communications protocol known to those skilled in the art.” (Darling p. 17, paragraph 4) (Emphasis added). Applicant submits that this statement would lead one of skill in the art to use a suitably adapted communications protocol such as TCP or UDP to transmit packets. Applicant submits that the Examiner has not provided a sufficient reason as to why one of skill in the art would digitize DTMF signals and place the digital DTMF information in the packets of Darling. Applicant submits that since the Examiner has not provided a sufficient reason as to why one of skill in the art would combine the references in the manner claimed, the Examiner has failed to prove a prima facie case of obviousness. Accordingly, for at least this reason Applicants respectfully request reconsideration of the rejection of claim 33.

Insomuch as claims 34, 35, 37, 41 depend directly or indirectly from claim 33 they too patentably define over the combination of references. Accordingly, for at least this reason Applicants respectfully request reconsideration of the rejections of claims 34, 35, 37, 41.

Independent claims 45, 125, 132, 139, 145, 153, and 155 recite similar elements to those of claim 33 and patentably define over the combination of references for at least similar reasons as claim 33. Accordingly, Applicant respectfully requests reconsideration of the rejections of claims 45, 125, 132, 139, 145, 153, and 155.

Insomuch as claims 46, 47, 49, 53, 126-128, 130-131, 133-135, 137, 138, 140, 141, 143, 144, 146, 147, 149, 150, and 154 depend directly or indirectly from claims 45, 125, 132, 139, 145, 153, and 155 they too patentably define over the combination of references. Accordingly, Applicant

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respectfully requests reconsideration of the rejections of claims 46, 47, 49, 53, 126-128, 130-131, 133-135, 137, 138, 140, 141, 143, 144, 146, 147, 149, 150, and 154.

Claims 81, 95, 109, 117, and 151 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Darling in view of Online Monopoly and Tanskanen.

Independent claims 81, 95, 109, 117, and 151 recite similar elements to that of claims 1 and claim 33 and patentably define over the combination of references for at least similar reasons as claims 1 and 33. Accordingly, Applicant respectfully requests reconsideration of the rejections of claims 81, 95, 109, 117, and 151.

Insomuch as claims 82, 83, 85, 88, 89, 91, 96, 97, 99, 102, 103, 105, 110, 112-116, 118, 120-124 depend directly or indirectly from claims 81, 95, 109, 117, or 151 they too patentably define over the combination of references. Accordingly, Applicant respectfully requests reconsideration of the rejections of claims 82, 83, 85, 88, 89, 91, 96, 97, 99, 102, 103, 105, 110, 112-116, 118, 120-124.

Date: May 16, 2008

/David M. Platz/

David M. Platz
Registration No. 60,013

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439

Doc Code: AP.PRE.REQ

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	First Named Inventor Scott Wolinsky																			
	Art Unit 3714	Examiner Dat Nguyen																		
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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